

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTHONY D. COMBE

Appeal No. 1998-0820
Application No. 08/274,771

ON BRIEF

Before JERRY SMITH, FLEMING and RUGGIERO, Administrative Patent Judges.

FLEMING, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-4 and 7-8. Claims 5-6 and 9-14 have been canceled.

The invention relates to a removable magneto-resistive hard disk cartridge system. The system provides for the interchange-ability of hard disk cartridges between disk

drives as well as for consistency in recording levels on the hard disk cartridges. An embedded servo method is used for magneto-resistive hard disk recording.¹

Independent claim 1 is as follows:

1. A rotating disk drive for the magnetic storage of computer data, comprising:

a grounded actuator arm with an inductive head for writing and a magneto-resistive (MR) read head for reading a plurality of data tracks with embedded servo features on a surface of a rotating magnetic rigid disk within a removable cartridge;

grounding means for connecting said rotating magnetic rigid disk to a disk drive ground and the actuator to provide electrostatic discharge (ESD) protection to said MR head, wherein the voltage potential between said MR head and said rotating magnetic rigid disk is limited to two to three volts; and

cartridge receiving means proximate to the magneto-resistive read head for accepting and ejecting said removable cartridge.

No prior art is relied upon by the Examiner in the rejection of claims under appeal.

Claim 2 is rejected under 35 U.S.C. § 112, second paragraph. Claims 1-4 and 7-8 are rejected under 35 U.S.C. § 112, first paragraph. Appellant has indicated that claims 1-4 and 7-8 stand or fall together.

¹See pages 4-5 of the specification.

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Rather than reiterate all arguments of Appellant and Examiner, reference is made to the briefs and answer for the respective details thereof.²

OPINION

We will not sustain the rejection of claim 2 under 35 U.S.C. § 112, second paragraph, nor of claims 1-4 and 7-8 under 35 U.S.C. § 112, first paragraph.

Turning first to the rejection of claim 2 under 35 U.S.C. § 112, second paragraph, the Examiner asserts that use of the term "conductive material" is unclear because "all materials are 'conductive'" and "the specification sets no conductive requirement to the protective material."³ Appellant responds that not all materials are conductive and provides examples that fall within that category.⁴

Analysis of 35 U.S.C. § 112, second paragraph, should begin with the determination of whether claims set out and

²See the brief filed January 10, 1997 and the answer mailed May 22, 1997.

³See page 5 of the answer.

⁴See page 8 of the brief.

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circumscribe the particular area with a reasonable degree of precision and particularity; it is here where definiteness of the language must be analyzed, not in a vacuum, but always in light of teachings of the disclosure as it would be interpreted by one possessing ordinary skill in the art. ***In re Johnson***, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977), citing ***In re Moore***, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (1971). "The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope." ***In re Warmerdam***, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

Claim 2 specifically recites "a protective layer of hard and conductive material capping said magneto-resistive read head." The sole issue under 35 U.S.C. 112, second paragraph, is whether the scope of protection sought by this language sets out and circumscribes a particular area with a reasonable degree of precision and particularity when viewed in light of teachings of the disclosure. The ordinary meaning of the term "conductive" as defined by the dictionary is "having conductance." The dictionary definition of conductance is

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"the ability of a component to conduct electricity."⁵ We find in view of the ordinary meaning of the term "conductive," Appellant's claim 2 meets the requirements of 35 U.S.C. § 112, second paragraph.

We turn next to the issue of the rejection of claims 1-4 and 7-8 for lack of written description. There are two issues presented to us: (1) whether the claims are supported by written description in the original filed specification and (2) whether amendments to the specification constitute new matter under 35 U.S.C. § 132.

With respect to the written description of claims in the originally filed application, the Examiner argues on page 6 of the answer that "grounding means for connecting said rotating magnetic rigid disk to a disk drive ground and the actuator to provide electrostatic discharge (ESD) protection to said MR head, wherein the voltage potential between said MR head and said rotating magnetic rigid disk is limited to two or three volts" was not properly described under 35 U.S.C. § 112, first paragraph.

⁵See Webster's New World Dictionary 290 (3d ed. 1986).

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As noted by our reviewing court, "[t]he function of the description requirement [of the first paragraph of 35 U.S.C. 112] is to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him." ***In re Wertheim***, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). "It is not necessary that the application describe the claim limitations exactly . . . but only so clearly that persons of ordinary skill in the art will recognize from the disclosure that appellants invented processes including those limitations." ***Wertheim***, 541 F.2d at 262, 191 USPQ at 96 ***citing In re Smythe***, 480 F.2d 1376, 1382, 178 USPQ 279, 284 (CCPA 1973). Furthermore, the Federal Circuit points out that "[i]t is not necessary that the claimed subject matter be described identically, but the disclosure originally filed must convey to those skilled in the art that applicant had invented the subject matter later claimed." ***In re Wilder***, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984), ***cert. denied***, 469 U.S. 1209 (1985), ***citing In re Kaslow***, 707 F.2d

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1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). "To fulfill the written description requirement, the patent specification 'must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."

Gentry Gallery Inc. v. Berkline Corp., 134 F.3d 1473, 1479, 45 USPQ 1498, 1503 (Fed. Cir. 1998) **citing In re Gosteli**, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). "An applicant is entitled to claims as broad as the prior art and **his disclosure** will allow." **In re Rasmussen**, 650 F.2d 1212, 1214, 211 USPQ 323, 326 (CCPA 1981). (Emphasis added).

On page 6 of the original specification, Appellant describes the hub 16 as being "included in disk drive 10" and as engaging "the hard disk 14 and [rotating] it . . ." In addition, Appellant notes that "it is preferable to ground hard disk 14 through hub 16 to disk drive 10." Therefore, it is clear that the term "hub" in this instance refers to the shaft connected to the spindle that is used by the motor to rotate the disk. Thus, if the hub were used to ground the disk to drive 10, it would itself have to be grounded.

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Because the hub is attached to the motor shaft spindle, the spindle would also be grounded.

Appellant also directs our attention to Figures 2 and 6. Appellant argues that reference numeral 25 points to the end of grounded actuator arm 18 which includes heads 20 and 22. In addition, Appellant argues that the originally filed Figure 6 has reference numeral 25 pointing to a box around MR read head 20. Appellant concludes that the skilled artisan would read from these figures "that something enveloping or surrounding the MR read head was grounded." Finally, Appellant notes that the originally filed specification limits the voltage difference between MR head 20 and hard disk 14 "to not exceed 2-3 volts."⁶

We agree and find that while the specification did not identically describe the claimed limitations at issue here, persons of ordinary skill in the art would have recognized from the passage found on page 6 as well as from Figures 2 and 6, that Appellant had possession of "grounding means for connecting said rotating magnetic rigid disk to a disk drive ground and the actuator to provide electrostatic discharge

⁶See page 12 of the specification.

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(ESD) protection to said MR head, wherein the voltage potential between said MR head and said rotating magnetic rigid disk is limited to two or three volts" as recited in claim 1 and thereby properly described under 35 U.S.C. § 112, first paragraph.

On page 5 of the answer, Examiner asserts that ESD protection recited in claim 1 was "newly described." However, page 6, lines 24-28, of the specification as originally filed describes grounding of both disk 14 and MR head 20 to drive 10 as a way of preventing damage by ESD to the read head. Thus, recitation of ESD protection recited in claim 1 was described in the specification as originally filed.

The Examiner argues on page 4 of the answer that "spindle rotation means connected to said cartridge receiving means for rotating said removable cartridge at a first speed while reading a track of data previously recorded by an inductive head at a second speed with said removable cartridge" does not have proper written description under 35 U.S.C. § 112, first paragraph. The Examiner asserts there "is no indication of any single

device . . . that writes at one speed and reads at another."⁷

Appellant argues on page 10 of the brief that claim 4, which formed part of the originally filed specification, recites "spindle rotation means connected to said cartridge receiving means for rotating [the] removable cartridge at a first speed while reading a track of data previously recorded by an inductive head at a second speed." Appellant goes on to note that a "two-speed spindle motor 52 simply represents an ordinary kind of spindle rotation means for independently rotating the removable cartridge at a first speed and a second speed." Appellant concludes that a fair reading of the specification will reveal "the drive can run the disk at two different speeds."

We note that the invention of claim 4 at the time of the filing date includes "spindle rotation means connected to receiving means for rotating said removable cartridge at a first speed while reading a track of data previously recorded by an inductive head at a second speed with removable cartridge." Therefore, because claim 4 recited the limitation originally filed, we find that this is evidence in and of

⁷See pages 4 and 8 of the answer.

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itself that the patent specification clearly conveys to persons of ordinary skill in the art that Appellant had invented what is claimed.

We note that we have addressed all of the Examiner's arguments relating to the rejection of claims 1-4 and 7-8 under 35 U.S.C. § 112, first paragraph. We will not sustain the rejection for the reasons set out above.

In regard to the issue of whether the amendment to the specification is new matter under 35 U.S.C. § 132, we find that because the amendment does not affect the claims before us, it is a petitionable issue and not an appropriate matter for decision by the Board.

For these reasons, we reverse the rejection of claim 2 under 35 U.S.C. § 112, second paragraph and the rejection of claims 1-4 and 7-8 under 35 U.S.C. § 112, first paragraph.

The decision of the examiner is reversed.

REVERSED

JERRY SMITH)
Administrative Patent Judge)
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